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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/396,531	09/15/1999	RANDALL A. ADDINGTON	99-1001	7582

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EXAMINER

PIERCE, WILLIAM M

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/396,531

Applicant(s)

ADDINGTON ET AL.

Examiner

William M Pierce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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DETAILED ACTION

This Final Action replaces the action set forth on 06/18/03 which has been expunged in favor of this new action are decided in the Decision on Petition dated 10/2/03 paper No. 39. Applicant's petition filed 6/26/03, paper No. 38, necessitated this new office action and his subsequent petition filed 10/08/03, paper No. 41, made the file unavailable to the examiner of record delaying this action. As such, applicant's Appeal Brief filed 10/24/03 has been withdrawn and the application stand finally rejected as follows.

Specification

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) as set forth in the previous office action. Examiner's objection to the drawings remains since applicant has only presented changes containing errors in attempts to overcome it. Applicant's amendments to the specification are not appropriate. Fig. 8 does not contain a reference number 24, 27, 12a, 12b, 18a and 18b.

Claim Rejections - 35 USC § 112

Claims 40-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 40 and 42, the scope of "maximum natural force" is indefinite. The term maximum relates to the intended use, by the strength of an individual, by the delivery of the ball and the weight of the ball. Such a variable is subjective. Claim 43 is inapt in that it fails to positively recite structure such that one can determine the metes and bounds of the claim. Currently the claim is only narrative with functional recitations that fail to further limit the elements in the previously recited claims.

Claim Rejections - 35 USC § 102

Claims 33, 34, 36, 38-43 and 45-58 are rejected under 35 U.S.C. 102(b) as being anticipated by Fowble as set forth in the previous office action.

Claim Rejections - 35 USC § 103

Claims 35, 37, 44 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fowble in view of Pratt as set forth in the previous office action.

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Response to Arguments

Applicant's arguments filed 1/14/03 have been fully considered but they are not persuasive.

I.

See above Examiner's objection to the drawings.

II.

The amendments to the claims are noted.

III.

An Office action does not use the explicit words such as "the fact are". Instead language used to present facts are for example, the "reference shows" or "teaches". As in the previous office action, these factual findings are clearly set forth for applicant in the grounds for rejection. Hence, the grounds for rejection remains as being proper.

IV

As to claim 33, 40, 46 the "force produce" is considered to be functionally recited. As such it is not considered to positively claim a "product found in nature" and the 101 has not been sustain with respect to these claims. As applicant's remarks are considered moot.

V.

Applicant's understanding is incorrect. The examiner meant claim 43 and this grounds for rejection remains. While applicant states that he has "amended claims 37 and 43, in a manner believed to avoid this rejection" applicant is reminded that only claim 44 has been amended and no amendments have been made to claim 43.

VI.

As to claims 40 and 42, applicant restates the MPEP. Obviously these excerpts are not disputed. However, they are incomplete. The core of 112 is that the metes and bounds of the claims must be determinable. If the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, a rejection of the claim under 35 U.S.C. 112, second paragraph would be appropriate. See *Morton Int'l, Inc. v. Cardinal Chem. Co.*, 5 F.3d 1464, 1470, 28 USPQ2d 1190, 1195 (Fed. Cir. 1993). As factually stated by the examiner to applicant, "the term maximum...is subjective" and in being so, imprecise rendering one incapable of determining the metes and bounds for the claims.

Likewise with respect to claim 43, one cannot determine the structure required by something that is "adapted to spread said force...substantially uniformly". Again one would not be able to determine the metes and bounds for this claim.

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The examiner has met his burden of presenting facts as to "why or how". The examiner was quite clear that these claims fail to set forth determinable metes and bounds since they are "subjective" and "narrative". When an examiner writes a rejection he may be brief which does not make a rejection improper. Nowhere is there any requirement for the examiner to be exhaustive when he presents a grounds for rejection. Clearly, it would be wasteful to have the examiner quote all applicable section from the MPEP and case law when making a rejection.

As to claims 40, 42 and 43, "maximum natural force" remains indefinite. Ball weights and bowlers are variables without defined ranges. Further the "force" is also a function of how a ball is delivered or thrown. As bowler who rolls a ball straight the pins would produce different forces than when he applies spin to the ball. What would be considered to be "substantially rigid" under these condition remains indefinite. Note that a claim may be rendered indefinite by reference to an object that is variable. For example, the Board has held that a limitation in a claim to a bicycle that recited "said front and rear wheels so spaced as to give a wheelbase that is between 58 percent and 75 percent of the height of the rider that the bicycle was designed for" was indefinite because the relationship of parts was not based on any known standard for sizing a bicycle to a rider, but on a rider of unspecified build. *Ex parte Brummer*, 12 USPQ2d 1653 (Bd. Pat. App. & Inter. 1989). As with here both the bowling ball and bowler are or unspecified characteristics and render the claim indefinite. Further the limitations in a claim must be timeless. The relationship between the ball, bowler and finger pad shield, the product it identifies, is indefinite, uncertain, and arbitrary since the formula or characteristics of the product may change from time to time. Known is that bowling styles, ball weights, finger grips are prone to change. This will affect what is considered to be "substantially rigid". Therefore, these known relationships are variable over time and as such render the claim indefinite since the scope of the claim is dependent upon them.

VII

Fowble meets the limitations of the recited claims. Applicant merely recites in claim 40 that the shield must be "substantially rigid" and only that it "resist deformation". Known is that the claims must be interpreted given their broadest most reasonable interpretation. In doing such "substantially rigid" and "resist deformation" is so broad as to encompass anything. Nothing about "resist deformation" is assumed to mean that it "does not deform". A piece of paper "resists deformation" of any force applied to it up to a certain point.

As to claim 38, and the "raised surface", nothing in the claim requires the surface to not be "in line with the rounded exterior of the protector" (pg. 10, 3rd to last ln.). The claims are also given their broadest interpretation. Further, the strap 5 is capable of contacting the surface of the bowling ball and limiting the in depth of insertion. Well

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settled is that if a prior art structure is capable of performing the intended use as recited in the preamble, then it meets the claim. See, e.g., *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

Examiners explicit application and interpretation of Flowble is well stated throughout the prosecution history. Applicant is directed all the way back to paper No. 5, 8/21/00. Applicant's subsequent arguments here amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. As such no further comment is deemed necessary

VIII

Applicant's citation of Pratt that he highlights does not state that the finger pad "must be tacitely resilient so the user can feel coins". Further, arguments pertaining to this false and misleading statement will not be further addressed so as not to cloud the record.

As with Fowble, the examiner position with respect to Pratt extends all the way back in the prosecution history to paper No. 5, 8/21/00. All the facts are clearly stated such that a patent professional can easily determine how the prior art meets the limitations of the claimed invention.

Applicant's declaration of Robert Addington fails to overcome the grounds for rejection. First, in any attempts it has been made to overcome the rejections under 35 USC 112, it is noted that expert opinion that an application meets the requirements of 35 U.S.C. 112 is not entitled to any weight. *In re Chilowsky*, 306 F.2d 908, 134 USPQ 515 (CCPA 1962) Second, it fails to present facts. The declaration renders applicant impressions regarding what he intends to be meant by "the force produced by the release of the ball. This is not fact. Lastly, an affidavit of an applicant as to the advantages of his or her claimed invention is less persuasive than that of a disinterested person. *Ex parte Keyes*, 214 USPQ 579 (Bd. App. 1982); *In re McKenna*, 203 F.2d 717, 97 USPQ 348 (CCPA 1953). As such, the declaration carries little weight to overcome the grounds for rejection set forth above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication and its merits should be directed to William Pierce at E-mail address bill.pierce@USPTO.gov or at telephone number (703) 308-3551.


Any inquiry not concerning the merits of the case such as **missing papers, copies, status or information** should be directed to Tech Center 3700 Customer Service Center at (703) 306-5648 where the fax number is (703) 308-7957 and the email is Customerservice3700@uspto.gov.

For **official fax** communications to be officially entered in the application the fax number is (703) 305-3579.

For **informal fax** communications the fax number is (703) 308-7769.

Any inquiry of a general nature or relating to the **status** of this application or proceeding can also be directed to the receptionist whose telephone number is (703) 308-1148.

Any inquiry concerning the **drawings** should be directed to the Drafting Division whose telephone number is (703) 305-8335.



WILLIAM PIERCE
[Signature]